

FILED UNDER SEAL PURSUANT TO PROTECTIVE ORDER

**IN THE UNITED STATES DISTRICT COURT  
FOR THE EASTERN DISTRICT OF TEXAS  
MARSHALL DIVISION**

UNILOC 2017 LLC,

Plaintiff

v.

GOOGLE LLC,

Defendant.

§  
§  
§  
§  
§  
§  
§  
§  
§  
§  
§  
§

Civil Action Nos. 2:18-cv-491, -492, -493,  
-496, -497, -499, -501, -503, -504

JURY TRIAL DEMANDED

**FILED UNDER SEAL PURSUANT TO  
PROTECTIVE ORDER**

**DEFENDANT GOOGLE LLC'S MOTION TO COMPEL DISCOVERY RESPONSES  
REGARDING LICENSING**

## FILED UNDER SEAL PURSUANT TO PROTECTIVE ORDER

**I. INTRODUCTION**

Defendant Google LLC (“Google”) moves to compel Plaintiff Uniloc 2017 LLC (“Uniloc”) to produce documents and respond to Google’s interrogatory regarding Uniloc’s licensing efforts and prior settlement agreements.

Seeking to avoid Court intervention, Google has repeatedly explained to Uniloc why Uniloc’s responses to this interrogatory are deficient. Google has likewise detailed why Uniloc’s document production of licenses and settlement agreements is inadequate, falling short of Uniloc’s production obligations. In fact, Uniloc has produced [REDACTED]. Based on Uniloc’s past litigation history, this cannot be the extent of Uniloc’s agreements relating to the asserted patents in the above-captioned cases. For example, Uniloc previously asserted U.S. Patent No. 6,836,654 (asserted here in the 493 case), against Huawei in *Uniloc 2017, LLC et al. v. Huawei Technologies, Co., Ltd. et al.*, No. 2:18-cv-00509 (E.D. Tex.). That case was dismissed with prejudice based on parties’ stipulated “agree[ment] to settle the . . . matter, and [the parties] therefore stipulate, under Federal Rule of Civil Procedure 41(a)(1)(A)(ii) to dismiss with prejudice all claims and counterclaims between the parties.” Despite Google’s numerous requests that Uniloc produce the resulting license and/or settlement agreement from at least that litigation, Uniloc categorically refuses to respond to Google’s request, let alone produce the relevant documents. Similarly, although Uniloc supplemented its interrogatory response, the “supplemental” response remains deficient and suffers from the same defects as the original response.

The requested information is highly relevant and is necessary for Google to meaningfully prepare for upcoming depositions, expert discovery, and trial. As the Federal Circuit instructs, “[l]icense agreements can be pertinent to the calculation of a reasonable royalty. . . . Our cases appropriately recognize that settlement agreements can be pertinent to the issue of reasonable royalties.” *In re MSTG, Inc.*, 675 F.3d 1337, 1339, 1348 (Fed. Cir. 2012). For the reasons set forth

## FILED UNDER SEAL PURSUANT TO PROTECTIVE ORDER

below, Google respectfully requests that the Court compel Uniloc to provide full and complete responses to Google's interrogatory concerning Uniloc's licensing efforts and prior settlement agreements, and produce related documents.

**II. FACTUAL BACKGROUND**

In July 2019, Google served its first set of interrogatories on Uniloc in all the above captioned cases. In July 2019, Google also sent Uniloc a letter identifying specific categories of documents that Uniloc was required to produce pursuant to Federal Rule of Civil Procedure 26, the Local Rules of the Eastern District of Texas, including Local Rule CV-26(d), and the terms of the Discovery Order and E-Discovery Order agreed to by the Parties. After obtaining an extension, in September 2019 Uniloc served its interrogatory responses and responded to Google's letter regarding document categories for production.

In November 2019, Google wrote to Uniloc and explained why Uniloc's interrogatory responses and document productions were deficient in all the above captioned cases. The parties met and conferred multiple times in December 2019 and January 2020, regarding Uniloc's interrogatory responses, and Uniloc agreed to substantively supplement its responses. Uniloc served supplemental interrogatory responses in January and February, 2020. Uniloc's supplemental responses failed to address the specific deficiencies previously raised by Google and instead maintained Uniloc's original objections, [REDACTED]. Nonetheless, Google once again identified the ongoing deficiencies in Uniloc's supplemental response in additional correspondence in February 2020. Most recently, Google wrote to Uniloc on February 18 and explained why Uniloc's production of relevant licenses and settlement documents was deficient. Despite Google's repeated efforts to meet and confer, Uniloc neither substantively responded to Google's disputes nor made itself available for the conference. The parties have reached an impasse.

## FILED UNDER SEAL PURSUANT TO PROTECTIVE ORDER

**III. LEGAL STANDARD**

The rules of discovery are “accorded a broad and liberal treatment to effect their purpose of adequately informing the litigants in civil trials.” *Herbert v. Lando*, 441 U.S. 153, 177 (1979). “Parties may obtain discovery regarding any nonprivileged matter that is relevant to any party’s claim or defense and proportional to the needs of the case . . . .” Fed. R. Civ. P. 26(b)(1). “Information within this scope of discovery need not be admissible in evidence to be discoverable.” *Id.* “Once the moving party establishes that the materials requested are within the scope of permissible discovery, the burden shifts to the party resisting discovery to show why the discovery is irrelevant, overly broad, or unduly burdensome or oppressive, and thus should not be permitted.” *SSL Servs., LLC v. Citrix Sys., Inc.*, No. 2:08-cv-158-TJW, 2010 WL 547478, at \*2 (E.D. Tex. Feb. 10, 2010). An interrogatory must “be answered separately and fully,” Fed. R. Civ. P. 33(b)(3), and must provide “all relevant, discoverable information.” *Stambler v. Amazon.com, Inc.*, No. 2:09-CV-310 (DF), 2011 WL 10538668, at \*3–4 (E.D. Tex. May 23, 2011). A party cannot “decid[e] which interrogatories (or subparts) to answer and which to ignore.” *Id.* at \*4.

**IV. ARGUMENT**

Google’s interrogatory seeks fundamental discovery concerning any potential damages in this case, such as Uniloc’s licensing efforts:

Identify each offer made by Plaintiffs, their Predecessors-in-Interest, or any other Person to any Third Party Regarding the licensing or sale of the Asserted Patent or any Related Patent, whether individually or in combination with any other patents.<sup>1</sup>

Uniloc’s January 24 supplemental response stated:

---

<sup>1</sup> Interrogatory No. 4 in the -491 case; Google propound substantially similarly worded Interrogatories in all above captioned cases. *See* Jones Decl. ¶ 2.

FILED UNDER SEAL PURSUANT TO PROTECTIVE ORDER

[REDACTED]

Google has also identified many categories of documents related to licensing, including:

- “All licenses or other agreements [Uniloc] has entered into . . . that relate to rights to the [asserted] Patent,”
- “All Documents Regarding any license . . . [to] the [asserted] Patent,”
- “All Documents Regarding any comparable licenses that would assist in determining a reasonable royalty applicable to the [asserted] Patent,” and
- “All Documents Regarding Plaintiffs’ licensing policies.”<sup>3</sup>

Despite Uniloc having entered dozens of settlements in patent cases in this District alone, its production of licenses, settlement agreements, and related documents, [REDACTED] do not constitute even a fraction of the documents that may be responsive to Google’s outstanding discovery requests when viewed in the context of Uniloc’s prior litigation and settlement history. Uniloc routinely enters settlement-related licenses, under which accused infringers pay a lump sum and receive a license to Uniloc’s entire portfolio (including any later-acquired patents). For example, [REDACTED]

[REDACTED]

[REDACTED]. And Uniloc has not denied that additional licenses exist that it has not produced. [REDACTED]

---

<sup>2</sup> Uniloc’s Supplemental Interrogatory response in all cases identified [REDACTED]. See Jones Decl. ¶ 4.

<sup>3</sup> Google’s July 23, 2019 letter regarding Uniloc’s disclosure obligations in the -491 case; Google propound substantially similarly worded categories of documents in all above captioned cases.

<sup>4</sup> In addition to [REDACTED]

See Jones Decl. ¶ 5.

[REDACTED], yet Uniloc refuses to provide any license or agreement despite Google's frequent requests. Google suspects, [REDACTED]

Such licenses and settlement agreements are particularly relevant because Uniloc does not practice the asserted patents—it merely licenses them. In such circumstances, this Court makes clear that licensing and settlement documents must be produced because “Plaintiff’s business is to litigate and license,” not to “openly compete with Defendants in the marketplace.” *Charles E. Hill & Assocs., Inc. v. ABT Elecs., Inc.*, 854 F. Supp. 2d 427, 430 (E.D. Tex. 2012) (Gilstrap, J.). Google therefore requests that the Court compel Uniloc to produce all documents responsive to the categories identified above and supplement its response to Google’s interrogatory concerning Uniloc’s licensing efforts and prior settlement agreements. *See, e.g., Sol IP, LLC v. AT&T Mobility LLC*, Nos. 2:18-cv-00526-RWS-RSP, *et al.*, 2020 WL 60140, at \*3 (E.D. Tex. Jan. 6, 2020) (ordering patentee to respond to interrogatory requiring that it “identify and describe in detail all Agreements or offers to make an Agreement between [patentee] and/or any third party regarding any Patent-in-Suit, and for each Agreement or offer to make an Agreement, identify all related

FILED UNDER SEAL PURSUANT TO PROTECTIVE ORDER

facts and circumstances, including but not limited to: dates on which negotiations began and ended; all Persons involved with negotiations or the decision to negotiate . . .”).

**V. CONCLUSION**

Google respectfully asks this Court to compel Uniloc to provide full and complete responses to Google’s interrogatory regarding settlements and licensing agreements, and produce related documents.

DATED: March 11, 2020

Respectfully submitted,

/s/ Michael C. Hendershot, with permission by  
Michael E. Jones

Michael C. Hendershot  
Tharan G. Lanier  
JONES DAY  
1755 Embarcadero Road  
Palo Alto, CA 94303  
Tel: (650) 739-3940  
Fax: (650) 739-3900  
[mhendershot@jonesday.com](mailto:mhendershot@jonesday.com)  
[tglanier@jonesday.com](mailto:tglanier@jonesday.com)

Tracy A. Stitt  
[tastitt@jonesday.com](mailto:tastitt@jonesday.com)  
JONES DAY  
51 Louisiana Avenue NW  
Washington, DC 20001  
Telephone: (202) 879-3641

Sanjiv P. Laud  
JONES DAY  
90 South Seventh Street  
Suite 4950  
Minneapolis, MN 55402  
Telephone: (612) 217-8879  
[slaud@jonesday.com](mailto:slaud@jonesday.com)

John D. Kinton (Calif. State Bar No. 203250)  
JONES DAY

FILED UNDER SEAL PURSUANT TO PROTECTIVE ORDER

4655 Executive Drive  
Suite 1500  
San Diego, CA 92121  
Telephone: 858.314.1190  
Facsimile: 844.345.3178  
Email: [jkinton@jonesday.com](mailto:jkinton@jonesday.com)

Michael E. Jones  
State Bar No. 10929400  
[mikejones@potterminton.com](mailto:mikejones@potterminton.com)  
E. Glenn Thames, Jr.  
State Bar No.00785097  
[glennthames@potterminton.com](mailto:glennthames@potterminton.com)  
Patrick C. Clutter  
State Bar No. 24036374  
[patrickclutter@potterminton.com](mailto:patrickclutter@potterminton.com)  
POTTER MINTON, P.C.  
110 N. College Ave., Suite 500  
Tyler, Texas 75702  
Tel: (903) 597-8311  
Fax: (903) 593-0846

**Attorneys for Defendants Google LLC**  
**2:18-cv-499**

*/s/ Robert Unikel, with permission by  
Michael E. Jones*

Robert Unikel  
Direct: 312-499-6030  
[robertunikel@paulhastings.com](mailto:robertunikel@paulhastings.com)  
Michelle Marek Figueiredo (IL Bar #6297112)  
[michellemarek@paulhastings.com](mailto:michellemarek@paulhastings.com)  
Matthew Richard Lind (IL Bar #6327241)  
[mattlind@paulhastings.com](mailto:mattlind@paulhastings.com)  
John A. Cotiguala (IL Bar #6311056)  
[johncotiguala@paulhastings.com](mailto:johncotiguala@paulhastings.com)  
PAUL HASTINGS LLP  
71 South Wacker Dr., 45<sup>th</sup> Floor  
Chicago, IL 60606  
Main: 312-499-6000  
Facsimile: (312) 499-6100

Elizabeth Louise Brann (CA Bar #222873)  
[elizabethbrann@paulhastings.com](mailto:elizabethbrann@paulhastings.com)  
Ariell Nicole Bratton (CA Bar #317587)



FILED UNDER SEAL PURSUANT TO PROTECTIVE ORDER

[ariellbratton@paulhastings.com](mailto:ariellbratton@paulhastings.com)

PAUL HASTINGS LLP

4747 Executive Drive, 12th Floor

San Diego, CA 92121

Telephone: (858) 458-3000

Facsimile: (858) 458-3005

Robert Laurenzi (NY Bar #3024676)

[robertlaurenzi@paulhastings.com](mailto:robertlaurenzi@paulhastings.com)

PAUL HASTINGS LLP

200 Park Avenue, 26th Floor

New York, NY 10166

Telephone: (212) 318-6000

Facsimile: (212) 318-6100

Michael E. Jones

State Bar No. 10929400

[mikejones@potterminton.com](mailto:mikejones@potterminton.com)

E. Glenn Thames, Jr.

State Bar No.00785097

[glennthames@potterminton.com](mailto:glennthames@potterminton.com)

Patrick C. Clutter

State Bar No. 24036374

[patrickclutter@potterminton.com](mailto:patrickclutter@potterminton.com)

POTTER MINTON, P.C.

110 N. College Ave., Suite 500

Tyler, Texas 75702

Tel: (903) 597-8311

Fax: (903) 593-0846

**Attorneys for Defendants Google LLC**

**2:18-cv-491**

**2:18-cv-492**

**2:18-cv-497**

**2:18-cv-501**

*/s/ Michael C. Hendershot, with permission by  
Michael E. Jones*

Michael C. Hendershot

Tharan G. Lanier

JONES DAY

1755 Embarcadero Road

Palo Alto, CA 94303

Tel: (650) 739-3940

Fax: (650) 739-3900

FILED UNDER SEAL PURSUANT TO PROTECTIVE ORDER

[mhenderson@jonesday.com](mailto:mhenderson@jonesday.com)

[tglanier@jonesday.com](mailto:tglanier@jonesday.com)

Sasha Mayergoyz

[smayergoyz@jonesday.com](mailto:smayergoyz@jonesday.com)

JONES DAY

77 W. Wacker Drive

Chicago, IL 60601

Telephone: (312) 782-3939

Michael E. Jones

State Bar No. 10929400

[mikejones@potterminton.com](mailto:mikejones@potterminton.com)

E. Glenn Thames, Jr.

State Bar No.00785097

[glennthames@potterminton.com](mailto:glennthames@potterminton.com)

Patrick C. Clutter

State Bar No. 24036374

[patrickclutter@potterminton.com](mailto:patrickclutter@potterminton.com)

POTTER MINTON, P.C.

110 N. College Ave., Suite 500

Tyler, Texas 75702

Tel: (903) 597-8311

Fax: (903) 593-0846

**Attorneys for Defendants Google LLC**

**2:18-cv-493**

*/s/ Michael E. Berta, with permission*

*by Michael E. Jones*

Michael A. Berta

(California Bar No. 194650)

[Michael.berta@arnoldporter.com](mailto:Michael.berta@arnoldporter.com)

Arnold & Porter

10th Floor

Three Embarcadero Center

San Francisco, CA 94111-4024

Tel: 415-471-3100

Fax: 415-471-3400

David Caine (California Bar No. 218074)

[David.Caine@arnoldporter.com](mailto:David.Caine@arnoldporter.com)

Telephone: (650) 319-4710

Bonnie Phan (California Bar No. 305574)

[Bonnie.Phan@arnoldporter.com](mailto:Bonnie.Phan@arnoldporter.com)

FILED UNDER SEAL PURSUANT TO PROTECTIVE ORDER

Telephone: (650) 319-4543  
Michael Nguyen  
[michael.nguyen@arnoldporter.com](mailto:michael.nguyen@arnoldporter.com)  
Tel: (650) 319-4718  
ARNOLD & PORTER KAYE SCHOLER LLP  
3000 El Camino Real  
Five Palo Alto Square, Suite 500  
Palo Alto, CA 94306-3807

Nicholas Lee (California Bar No. 259588)  
[Nicholas.Lee@arnoldporter.com](mailto:Nicholas.Lee@arnoldporter.com)  
ARNOLD & PORTER KAYE SCHOLER LLP  
777 South Figueroa Street  
44th Floor  
Los Angeles, CA 90017-5844  
Telephone: (213) 243-4156

Nicholas Nyemah (DC Bar No. 1005926)  
[Nicholas.Nyemah@arnoldporter.com](mailto:Nicholas.Nyemah@arnoldporter.com)  
Telephone: (202) 942-6681  
Paul Margulies (DC Bar No. 1000297)  
[Paul.Margulies@arnoldporter.com](mailto:Paul.Margulies@arnoldporter.com)  
Telephone: (202) 942-6990  
ARNOLD & PORTER KAYE SCHOLER LLP  
601 Massachusetts Ave., NW  
Washington, DC 20001-3743

Mark Samartino (Illinois No. 6313889)  
[Mark.Samartino@arnoldporter.com](mailto:Mark.Samartino@arnoldporter.com)  
ARNOLD & PORTER KAYE SCHOLER LLP  
70 West Madison Street  
Suite 4200  
Chicago, IL 60602-4321  
Telephone: (312) 583-2437

Michael E. Jones  
State Bar No. 10929400  
[mikejones@potterminton.com](mailto:mikejones@potterminton.com)  
E. Glenn Thames, Jr.  
State Bar No.00785097  
[glennthames@potterminton.com](mailto:glennthames@potterminton.com)  
Patrick C. Clutter  
State Bar No. 24036374  
[patrickclutter@potterminton.com](mailto:patrickclutter@potterminton.com)  
POTTER MINTON, P.C.  
110 N. College Ave., Suite 500

FILED UNDER SEAL PURSUANT TO PROTECTIVE ORDER

Tyler, Texas 75702  
Tel: (903) 597-8311  
Fax: (903) 593-0846

**Attorneys for Defendant Google LLC**

**2:18-cv-496**

**2:18-cv-503**

**2:18-cv-504**

FILED UNDER SEAL PURSUANT TO PROTECTIVE ORDER

**CERTIFICATE OF CONFERENCE**

Pursuant to Local Rules CV-7(h) and (i), counsel for the parties met and conferred multiple times in December 2019 and January 2020 in a good faith attempt to resolve the matters raised by this motion. Since February 2020, counsel for the Plaintiff neither substantively responded to counsel for the Defendant's requests to supplement its discovery responses related to this motion, nor made itself available for a conference regarding the same, despite counsel for Defendant's request to meet and confer. Thus, the parties have reached an impasse and leave an open issue for the Court to resolve.

/s/ Michael E. Jones

Michael E. Jones

**CERTIFICATE OF SERVICE**

I hereby certify that all counsel of record who have consented to electronic service are being served with a copy of this document via electronic mail on March 11, 2020.

I also hereby certify that all counsel of record who have consented to electronic service are being served with a notice of filing of this document, under seal, pursuant to L.R. CV-5(a)(7) on March 11, 2020.

/s/ Michael E. Jones

Michael E. Jones

**CERTIFICATE OF AUTHORIZATION TO SEAL**

I hereby certify that under Local Rule CV-5(a)(7), the foregoing document is filed under seal pursuant to the Court's Protective Order entered in this matter.

/s/ Michael E. Jones

Michael E. Jones